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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,561	02/01/2001	Gee-Kee Sim	HKZ-029CPUS	2245

26949 7590 09/19/2002

HESKA CORPORATION  
INTELLECTUAL PROPERTY DEPT.  
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FORT COLLINS, CO 80525

EXAMINER

ROARK, JESSICA H

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 09/19/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/646,561

Applicant(s)

SIM ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,8,10-14,16-19,21,23,25-27 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-3,6,8,10-14,16-19,21,23,25-27 and 37-39.

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### DETAILED ACTION

1. Applicant's amendment, filed 9/3/02, is acknowledged.

Claims 4-5, 7, 9, 15, 20, 22, 24 and 28-36 have been cancelled.

Claims 1-2, 6, 8, 10-14, 16-19, 21, 23, 25-27 and 37-38 have been amended.

*Claims 1-3, 6, 8, 10-14, 16-19, 21, 23, 25-27 and 37-39 are pending and being acted upon presently*

2. Applicant's amendment to more clearly define the elected invention is acknowledged with appreciation, as is the inclusion of a Table setting forth the relationship of the instant SEQ ID NOS.

3. Applicant's election with traverse of Group II in Paper No. 16 is acknowledged.

A) The traversal is first on the grounds that the subject matter of Groups II (canine B7-2) and IV (feline B7-2) is highly related structurally (90% identity at the nucleotide level) and shares a common function of costimulating T cell proliferation. Applicant also points out that many of the instant SEQ ID NOS also represent true fragments of the full length SEQ ID NOS.

In view of this information it appears that the canine and feline nucleic acids of the instant Markush group are more appropriately treated as Species rather than Groups.

*The restriction requirement between Groups II and IV is hereby withdrawn. A supplemental species election follows.*

B) The traversal is second on the grounds that the subject matter of Groups II and XXIII and Groups IV and XXV do not describe independent inventions because the methods require the products recited in Groups II and IV.

It is first noted that the instant claims were subject to restriction under 35 U.S.C. 121 and 372, and that lack of unity practice applies.

The Examiner has previously established that the groups of inventions were not so linked as to form a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lacked the same or corresponding special technical features in view of the prior art of El Tayar et al. (US Pat. No. 6,337,316, of record) (see entire document).

It is further noted that although the methods recite the products of Groups II and IV (i.e., they are related as product and process of using MPEP 806.05(h)), the methods may nevertheless be practiced with other materially different product. For instant, a method of regulating a T cell mediated immune response may be accomplished by administering antibodies to CD3, in addition to administering B7-2 nucleic acids. Thus although the methods and products are related, they are distinct.

*The requirement with respect to Groups II/IV and XXIII/XXV is still deemed proper and is therefore made FINAL.*

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C) Applicant's comments regarding rejoinder are acknowledged. However, the issue is held abeyance until such time as allowable subject matter is identified.

***Supplemental Species Requirement***

4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- A) canine B7-2 nucleic acids, or
- B) feline B7-2 nucleic acids.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The technical feature shared by the canine and feline nucleic acids is that they are each B7-2 nucleic acids.

Human B7-2 nucleic acids were known in the art at the time the invention was made, as acknowledged in the specification on page 2 at lines 4-16, especially lines 13-14; thus canine B7-2 and feline B7-2 lack a special technical feature that defines a contribution over the prior art.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Jessica Roark, Ph.D.  
Patent Examiner  
Technology Center 1600  
September 17, 2002

PHILLIP GAMBEL  
PHILLIP GAMBEL, PH.D  
PRIMARY EXAMINER  
TECH CENTER 1600  
9/18/02